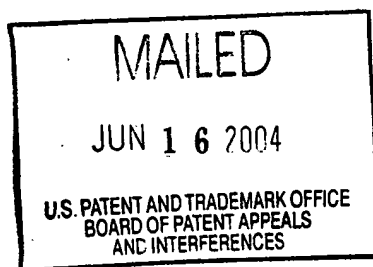The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte ADEN DALE HIATT, JR.

_____

Appeal No. 2003-0655
Application No. 09/406,001

_____

ON BRIEF

_____

Before JERRY SMITH, FLEMING and MACDONALD, **Administrative Patent Judges**.

MACDONALD, **Administrative Patent Judge**.

## DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-11 and 13-20.

## Invention

Appellant's invention relates to a system and method for transferring an address list (Appellant's specification, page 1, lines 5-7). A portable wireless device 12 (figure 1), such as a

cellular telephone 52, personal digital assistant 54, personal computer 56, or pager (figure 2 and

spec. at page 5, lines 3-4), has a wireless communication link 14 with a wireless communication

system 16. The wireless communication system 16 is connected to a wireline communication

system 18. A computer 20 is connected to the wireline communication system 18. The

computer 20 runs address software that sends a plurality of addresses (or a single address) to the

portable wireless device 12. In addition, the address software is used to receive addresses from

the portable wireless device 12 (spec. at page 4, lines 15-25). The address software updates an

address file in the portable wireless device (Appellant's spec at page 6, line 22).

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A system for transferring an address list, comprising:

a personal communication device containing an address database:

a wireless communication system capable of establishing a wireless communication link
with the personal communication device;

a wireline communication network connected to the wireless communication system;
and

a computer connected to the wireline communication network, the computer containing
an address software that is capable of extracting a plurality of addresses in an address database
and sending the plurality of addresses to the personal communication device, the personal
communication device storing the plurality of addresses in the address database of the personal
communication device, wherein the computer is not part of the wireline communication network
and is not part of the wireless communication system.

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## References

The references relied on by the Examiner are as follows:

| | | |
|---|---|---|
| Pepe et al. (Pepe) | 5,742,668 | Apr. 21, 1998 |
| Günlük | 5,768,509 | June 16, 1998 |
| LaDue | 6,144,859 | Nov. 7, 2000 |

Miller, Grant ; "Import Personal Address Book (PAB) to Outlook 97."; WWU University Residences, December 3, 1997. (This is a single page reference.)

OL97: How to Copy the Personal Address Book to Another Computer; Microsoft Publication Q169709; November 14, 2000.

OL97: User Profiles and Information Services; Microsoft Publication Q162203; February 22, 2001.

## Rejections At Issue

Claims 1-11, 13, 14, 16, and 18-20 stand rejected under 35 U.S.C. § 103 as being obvious

over the combination of Pepe and Miller. Claims 15 and 17 stand rejected under 35 U.S.C. § 103

as being obvious over the combination of Pepe, Miller, and Günlük.

Throughout our opinion, we make references to the Appellant's brief, and to the

Examiner's Answer for the respective detail thereof.[1]

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[1] Appellant's brief filed June 17, 2002, and the Office communication mailed October 1, 2002.

**OPINION**

With full consideration being given to the subject matter on appeal, Examiner's rejections

and the arguments of Appellant and Examiner, for the reasons stated **infra**, we reverse the

Examiner's rejection of claims 1-11 and 13-20 under 35 U.S.C. § 103.

I.    **Can a reference that has a date after the filing date of the application be used to show that a claim is obvious?**

The Examiner relies on Microsoft Publications Q162203 dated February 22, 2001 and

Q169709 dated November 14, 2000, to show the details of operation of the Miller reference.

These Microsoft references are dated after Appellant's filing date and are not legally prior art.

Appellant argues, "[t]hus, the reference of these publications provides no legal or logical support

for the examiner's position" (brief, page 14).

We note that the Examiner is relying on hearsay statements (the two Microsoft

publications) about the operation of the system described in Miller. The statements are out-of-

court written assertions offered by the examiner to prove the truth of the matter asserted, namely,

that Miller's importing of a personal address book to Outlook 97 worked in a certain way before

the date of the publications.

It is our view that the Examiner was correct in his reliance on the Microsoft publications.

"The general rule is that administrative agencies like the PTO are not bound by the rules of

evidence that govern judicial proceedings." **In re Epstein**, 32 F.3d 1559, 1565, 31 USPQ2d

1817, 1821 (Fed. Cir. 1994). Indeed, in ex parte patent prosecution, hearsay may properly be

considered. **See, e.g., In re Reuter**, 670 F.2d 1015, 1020-21, 210 USPQ 249, 254-55 (CCPA

1981).

## II.    Whether the Rejection of Claim 1 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon

and the level of skill in the particular art would not have suggested to one of ordinary skill in the

art the obviousness of the invention as set forth in claim 1. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of

establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445,

24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472,

223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that

some objective teaching in the prior art or knowledge generally available to one of ordinary skill

in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d

1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming

forward with evidence or argument shift to the Appellants. **Oetiker**, 977 F.2d at 1445,

24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent

evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must

necessarily weigh all of the evidence and argument." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at

1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence

of record, but must also explain the reasoning by which the findings are deemed to support the

agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir.

2002).

Independent claim 1 stands rejected under 35 U.S.C. § 103 as being unpatentable over the

combination of Pepe and Miller. Appellant argues, "claim 1 requires a personal communication

device, defined as a cellular telephone, pager, or PDA (See Background of Invention, Page 1,

lines 11-14). There is no suggestion that Outlook 97 works with any of these products" (brief,

pages 10-11).

In response, the Examiner points out that Appellant specifically includes a portable

computer among his list of personal communication devices in the specification at page 5,

lines 1-5. Therefore, Appellant's argument on this point is unpersuasive. The language of

claim 1 is not limited to any particular "personal communication device" and the device of the

combination of Pepe and Miller meets the claim language.

Appellant further argues, "Miller never discusses transferring addresses between two

devices" (brief, page 11, lines 14-15). The Examiner points out that e-mail inherently requires

two computers (answer, page 5, first full paragraph). We do not choose to base our decision on

this point on inherency. Rather, the Q169709 Microsoft document, used to show the details of

Miller, explicitly states that addresses are transferred between two devices (Q169709 Summary).

Therefore, we find Appellant's argument unpersuasive.

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Finally, Appellant argues, Miller fails to teach storing the plurality of addresses in the address database of the personal communication device (brief, page 11, lines 3-14). The Examiner points out that the teaching of Miller shows that the portable device's original address file could be fully replaced by the new address file sent from the computer. The Examiner then argues that this "replacement" reads on the current invention (answer, page 4, last paragraph). We find the Examiner's reading of the Miller reference to be correct. However, we do not agree that "replacement" meets the language of claim 1. Claim 1 specifically requires storing "in the address database." Therefore, this argument by Appellant is persuasive and we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

### III. Whether the Rejection of Claims 2, 4, and 5 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 2, 4, and 5. Accordingly, we reverse.

As noted above with respect to independent claim 1, Appellant argues, "claim 1 requires a personal communication device, defined as a cellular telephone, pager, or PDA (See Background of Invention, Page 1, lines 11-14). There is no suggestion that Outlook 97 works with any of these products" (brief, pages 10-11).

The Examiner's rebuttal was persuasive on this point with respect to claim 1. However, such is not the case for claim 2. The language of claim 2, is limited to a particular personal

communication device.  Claim 2 requires a "cellular telephone" and the device of the

combination of Pepe and Miller does not meet the claim language.  Therefore, Appellant's

argument on this point is persuasive.  We will not sustain the Examiner's rejection under

35 U.S.C. § 103.

## IV.  Whether the Rejection of Claim 3 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon

and the level of skill in the particular art would not have suggested to one of ordinary skill in the

art the obviousness of the invention as set forth in claim 3 for the reasons discussed above with

respect to claims 1 and 2 from which it depends.  Accordingly, we reverse.

However, we additionally note that Appellant separately argues, "examiner never

provided a prior art reference" to support the finding of Official Notice as required by MPEP

§ 2144.03 (brief, page 11, last paragraph).  The Examiner's rebuttal is persuasive on this point

with respect to claim 3.  The record clearly shows that the LaDue reference was supplied in the

Final Rejection (paper number 15) to support the taking of Official Notice.  Therefore,

Appellant's argument on this point is unpersuasive.

## V.  Whether the Rejection of Claims 6-9 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon

and the level of skill in the particular art would not have suggested to one of ordinary skill in the

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art the obviousness of the invention as set forth in claim 6 for the reasons discussed above with

respect to claims 1 and 2 from which it depends. Accordingly, we reverse.

## VI.    Whether the Rejection of Claim 10, 11, and 16 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon

and the level of skill in the particular art would not have suggested to one of ordinary skill in the

art the obviousness of the invention as set forth in claims 10, 11, and 16. Accordingly, we

reverse.

Independent claim 10 stands rejected under 35 U.S.C. § 103 as being unpatentable

over the combination of Pepe and Miller. Appellant argues that Pepe does not inherently

comprise a step of selecting or using transfer software as pointed out by the Examiner at page 5

of the Final Rejection (brief, page 12). However, what is before us is not Pepe standing alone,

rather it is the combination of Pepe and Miller. In response, the Examiner points out that the

combination of Pepe and Miller inherently includes software and points to the e-mail of Miller.

One cannot show nonobviousness by attacking references individually where the rejections are

based on combinations of references. **See In re Keller**, 642 F.2d 413, 426, 208 USPQ 871, 882

(CCPA 1981); **In re Merck & Co.**, 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986).

The device of the combination of Pepe and Miller meets the software language of claim 10.

Therefore, Appellant's argument on this point is unpersuasive.

Also with respect to claim 10, we note that the "in the address database" language of

claim 1 discussed above has a parallel in step (d) of claim 10. The "to the second address book"

language of step (d) is not met by the act of file "replacement" as discussed above with respect to

claim 1. For this reason alone, we will not sustain the Examiner's rejection under

35 U.S.C. § 103.

## VII. Whether the Rejection of Claims 13 and 14 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon

and the level of skill in the particular art would not have suggested to one of ordinary skill in the

art the obviousness of the invention as set forth in claims 13 and 14 for the reasons discussed

above with respect to claim 10 from which it depends. Accordingly, we reverse.

## VIII. Whether the Rejection of Claims 15 and 17 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon

and the level of skill in the particular art would not have suggested to one of ordinary skill in the

art the obviousness of the invention as set forth in claims 15 and 17 for the reasons discussed

above with respect to claim 10 from which it depends. Accordingly, we reverse.

## IX. Whether the Rejection of Claims 18-20 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 18-20. Accordingly, we reverse.

Unlike claim 1 which requires "a personal communication device containing an address database" and "storing the plurality of addresses in the address database," claim 18 is broader. Claim 18 requires "storing the plurality of addresses in an address list of the electronic device." With respect to claim 1, Appellant argues Miller and the Microsoft documents teach, "the said addresses are stored in a new address database not in said address database" (brief, page 11, lines 10-12). We find claim 18 does not have a "said address database" nor a "said address list." Rather this portion of claim 18 only requires the act of storing in an address list.

Independent claim 18 stands rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Pepe and Miller. The Examiner states in the final rejection at page 7, "Pepe discloses a method for transferring information from a computer . . . inherently using a program." Appellant argues, "[t]he claim actually requires address transfer software not just transfer software" and "[t]here is no mention in Pepe et al., of transferring addresses" (brief, page 13). However, what is before us is not Pepe standing alone, rather it is the combination of Pepe and Miller. In response, the Examiner points out that the combination of Pepe and Miller inherently includes software and points to the e-mail of Miller (answer, page 7, second paragraph). One cannot show nonobviousness by attacking references individually where the

rejections are based on combinations of references. **See Keller**, 642 F.2d at 426, 208 USPQ at

882; **Merck & Co.**, 800 F.2d at 1097, 231 USPQ at 380.

Now, the question before us is, what would the combination of Pepe and Miller (with the

Microsoft documents to show the operational details of Miller) have taught to one having

ordinary skill in the art? To answer this question, we find the following facts:

1.      Pepe shows at column 1, lines 17-26, "a mobile office."

2.      Pepe shows at figure 1, "a personal communications internetworking ("PCI")" for

        communication between devices on the network.

3.      Pepe shows at figure 1, item 22, that the PCI includes "an e-mail terminal"

        comprising a computer.

4.      Pepe shows at figure 1, item 30, that the PCI includes "a personal digital assistant

        (PDA)" comprising an electronic device in the form of a wireless notebook computer

        terminal.

5.      Pepe at column 3, lines 20-25, and column 17, lines 64-67, shows the sending and

        receiving of e-mail over the PCI network.

6.      Pepe states at column 5, line 37, that "routing addresses" are used for the wireless

        terminals on the network.

7.      Pepe at column 3, lines 20-25, and column 17, lines 64-67, shows the sending and

        receiving of email over the PCI network.

8.      Miller at lines 4-14 shows receiving an e-mail ("In your Inbox") including a file

        attachment ("Save Attachments") containing a plurality of addresses ("address book

will be imported"), which are then saved (line 7, "click 'Save'") on an electronic

device in the form of a second computer (see the SUMMARY and MORE

INFORMATION of Microsoft document Q169709).

9.    Microsoft document Q169709 shows that the plurality of addresses in the file

attachment of Miller was extracted from an address database at a first computer

(SUMMARY and Identify the PAB File Your Mail Profile Uses).

10.    Miller at line 4 shows attaching the file containing the extracted plurality of addresses

to an e-mail message ("there will be a message").

Appellant's specific argument that Pepe fails to teach, "transferring addresses" is

unpersuasive. We find that Pepe indicates the need for an e-mail system to support a mobile

office and the hardware system to support the e-mail. Pepe is silent as to the details of how the

e-mail would function and is silent as to how the system user would add or store his client's

e-mail addresses at the mobile office. We find that one of ordinary skill in the art would be

motivated to look to the prior art for a solution to implementing these details. We find that

Miller shows these details. The combination of Pepe and Miller, with the supporting Microsoft

documents, would have suggested to one of ordinary skill in the art the obviousness of the

general "transferring of addresses" and the details of how that transfer occurs as shown in the

combination.

However, claim 18 recites more than this. In addition, claim 18 requires "requesting an

electronic address of an electronic device, <u>when</u> the address transfer option is selected"

(emphasis added). The combination of Pepe and Miller fails to show this feature. This combination of references would have suggested to one of ordinary skill in the art the obviousness of "transferring of addresses," but without more these references would **not** have suggested the obviousness of the invention of claim 18. For this reason, we will not sustain the Examiner's rejection of claim 18. Therefore, the rejection of claims 18-20 under 35 U.S.C. § 103 is reversed.

### Other Issues

We note that the Examiner has used a single page (the Miller reference) and supporting Microsoft publications in support thereof to show functions found in software product "Outlook 97." The Examiner should consider whether Pepe in combination with the software product "Outlook 97" itself (in its entirety) is appropriate art for a rejection under 35 U.S.C. § 103.

Also, we note that the Examiner has not searched Class 707 - Databases. A cursory search shows numerous patents, such as, Robertson 6,269,369 or Weiser et al. 5,786,819 or Wright, Jr. et al. 6,324,542 or Siitonen et al. 6,049,796 or Nagatomo et al. 6,334,126 which seem to be pertinent to claim 1. The Examiner should consider whether these patents or others from this art area are appropriate for a rejection under 35 U.S.C. § 102 or § 103 when used in combination with the references already cited in this application.

Additionally, the Examiner should address whether claims 14 and 20 are proper

35 U.S.C. § 112, second paragraph claims.  There is no antecedent basis for "the file of

addresses" in claims 10 and 18 from which claims 14 and 20 respectively depend.

Lastly, the Examiner should address whether "computer program" claims 18-20 are

proper 35 U.S.C. § 101 claims given that these claims may be directed to a "computer program"

**per se.**

## Conclusion

In view of the foregoing discussion, we have reversed the Examiner's rejection of claims

1-11 and 13-20 under 35 U.S.C. § 103.

**REVERSED**

JERRY SMITH                                              )
Administrative Patent Judge                              )
                                                        )
                                                        )
                                                        )
MICHAEL R. FLEMING                                      ) BOARD OF PATENT
Administrative Patent Judge                              )    APPEALS
                                                        )    AND
                                                        ) INTERFERENCES
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ALLEN R. MACDONALD                                      )
Administrative Patent Judge                              )

ARM:psb

Appeal No. 2003-0655
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Law Office of Dale B. Halling
24 South Weber Street
Suite 311
Colorado Springs, CO  80903